it is noted that the term "bioprecursor" is a well recognized term of art in this field. This term has been granted in US patents as they relate to structurally similar compounds.

In light of these remarks and amendments withdrawal of the rejection to the claims under 35 USC §112, first and second paragraphs is respectfully requested.

Rejection under 35 USC §102(b)

Claims 1 and 4 are rejected under 35 USC §102(b) as being anticipated by Kenig et al., or Sutton et al. or Boyd et al. Applicants respectfully traverse this rejection.

Applicants do not know which Sutton et al. reference the Examiner is referring to in this rejection. There are no earlier applications relating to penciclovir which Sutton is named as the first inventor on. Therefore, Applicants can not therefore respond to it. Clarification is requested.

The Kenig et al., and the Boyd et al. reference do not disclose penciclovir triphosphate, nor do they disclose the (R)-isomer of this compound. Both the Kenig et al. and the Boyd et al. patent application as are directed to different uses of Penciclovir. There is no teaching that phosphate esters of penciclovir could exist as enantiomers. Therefore, these references fail to directly anticipate the claims herein as required under the provisions of §102.

In light of these remarks, and amendments, reconsideration and withdrawal of the rejection to claims 1 and 4, under 35 USC §102(b) is respectfully requested.

Rejection under 35 USC §103

Claims 1 and 4 are rejected under 35 USC §103 as being unpatentable over Kenig et al., Sutton et al. or Boyd et al. Applicants respectfully traverse these rejections.

As noted above, Applicants do not know which Sutton et al. reference the Examiner is referring to in this rejection. There are no earlier applications relating to penciclovir which Sutton is named as the first inventor on. Therefore, Applicants can not therefore respond to it. Clarification is requested.

The Kenig et al. and Boyd et al. references do not disclose that phosphate esters of penciclovir could exist as enantiomers. The Kenig et al., and Boyd et al. references do not provide any teachings to direct the skilled person on how to synthesize the specific phosphate esters, (R) and (S) PCV-TP, in enantiomerically pure form. Neither do the Kenig et al. or Boyd et al. references provide any motivation on how such a

synthesis could be achieved. Specific methodology was necessarily developed in order to have an enantiomeric synthesis which could separate these two isomers.

It could not have been predicted that the (R) PCV-TP enantiomer would be a more active inhibitor of HBV DNA polymerases and HIV-1 reverse transcriptase than the (S)-enantiomer of PCV. Data supporting this activity is provided for in the specification on page 4, lines 14-22, and in the attached copies of the two references cited therein.

Applicants also draw the Examiners attention to the typographical error on page 4, line 18 in which H36 should be H66 as shown in the article.

There is no teaching, nor motivation in the Kenig et al. or Boyd et al. references to direct the skilled artisan to separate the isomers, nor that one of the isomers would posses the unexpected activity of being significantly more inhibitory against HIV-1 reverse transcriptase than the other.

In light of this unexpected result, Applicants respectfully request reconsideration and withdrawal of the rejection to Claims 1 and 4 under 35 USC §103.

Conclusion

Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned at the number below. It is not believed that this paper should cause any additional fees or charges to be required, other than expressly provided for already. However, if this is not the case the Commissioner is hereby authorized to charge Deposit account 19-2570 accordingly.

Respectfully submitted,

Dara L. Dinner
Attorney for Applicants
Registration No. 33,680

SmithKline Beecham Corporation
Corp. Intellectual Property (UW2220)
P.O. Box 1539
King of Prussia, PA 19406-0939
(610) 270-5017 - telephone
(610) 270-5090 - facsimile
oa\us\31158\31158oa2.doc